

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/749,793

Filing Date: December 1, 2003

Title: Dual Diffusion Channel Filter

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Dkt: 00758.1316US01

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on November 16, 2005, and the references cited therewith. Applicant respectfully requests reconsideration of the pending claims in view of the above amendments and the following comments.

Claim 27 has been canceled. Claims 1-26 are now pending in this application.

Abstract of the Disclosure

The Examiner objected to the length of the abstract of the disclosure. In response, Applicants have amended the abstract of the disclosure in order to obviate this objection. Applicants respectfully request that this objection be withdrawn.

Editorial Changes

The Examiner requested various editorial changes to the specification. In response, Applicants have amended the specification accordingly. However, Applicants believe that the word "is" is proper at page 7, line 16.

§ 103 Rejection of the Claims

Claims 1-27 were rejected under 35 USC § 103(a) as being unpatentable over Tuma (U.S. Pub. No. 2002/0089781) in view of Dauber (U.S. Pat. No. 5,417,743). Applicants respectfully traverse this rejection.

Tuma discloses a filter construction for use in disk drive enclosures. The Examiner acknowledges that Tuma fails to disclose a second diffusion channel which is in communication with the inside of the housing enclosure. Applicants assert that Dauber fails to cure the deficiencies of Tuma.

Dauber discloses a self-adhesive vent filter and adsorbent assembly with a diffusion tube. The Examiner states that Dauber shows a diffusion channel "5" that is in communication with a housing enclosure "15". The Examiner goes on to argue that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the portion of filter construction '10' of Tuma (2002/0089781) which is in communication with housing enclosure

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'12' to include a diffusion channel, in view of the showing of Dauber ('743), so that the flow between the filter apparatus and the inside of the enclosure will be controlled."

In response, Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness. *Prima facie* obviousness requires some suggestion or motivation to combine reference teachings. See MPEP § 2142. The teaching to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. See MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). In addition, the prior art must suggest the desirability of the claimed invention. See MPEP § 2143.01. Finally, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination." MPEP § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In this case, neither Tuma nor Dauber suggests the usefulness of the claimed invention. Specifically, neither Tuma nor Dauber suggest the usefulness of "a first diffusion channel, the first diffusion channel configured and arranged to provide fluid communication between the interior chamber of the housing and the inside of the electronic enclosure; and a second diffusion channel, the second diffusion channel configured and arranged to provide fluid communication between the interior chamber of the housing and the exterior of the electronic enclosure" as required by claim 1, or "a first diffusion channel, the first diffusion channel configured and arranged to provide fluid communication between the cavity and the first aperture; a second diffusion channel, the second diffusion channel configured and arranged to provide fluid communication between the cavity and the second aperture" as required by claim 14. Therefore, there is no motivation to combine the references. For at least this reason, *prima facie* obviousness has not been established. Accordingly, the combination of Tuma and Dauber fails to render the invention of claims 1 and 14 obvious. As claims 2-13 are dependent on claim 1, and as claims 15-26 are dependent on claim 14, these claims are also not rendered obvious. Applicants respectfully request that this rejection be withdrawn.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-746-4782) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3688

Respectfully submitted,

VIJAY K. GARIKIPATI ET AL.

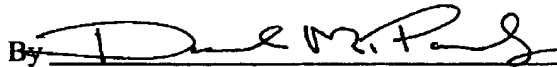
By their Representatives,

Pauly, DeVries Smith & Deffner, L.L.C.
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Date

3/28/2006

By



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